

Serial No. 10/666,594
Filed: September 18, 2003

REMARKS

Claims 1 to 73 are pending. No claims have been added, cancelled, or amended in this response. No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

RESTRICTION REQUIREMENT AND ELECTION OF SPECIES

Applicants note that the Restriction Requirement has not been made final and, thus, Applicants are not entitled to petition the requirement at this time. However, should the requirement be made final in its present form, Applicants intend to petition the requirement for the reasons provided in the response filed November 23, 2005 (incorporated by reference herein), for the reasons provided below, and because the examined subject matter does not encompass the species elected in the response filed November 23, 2005.

The claims were restricted to the following five groups:

- I. Claims 1 to 54 and 67 drawn to compounds and compositions;
- II. Claims 55 to 63 and 68 drawn to compounds and compositions;
- III. Claims 64 to 66 drawn to compounds;
- IV. Claims 69 to 71 drawn to a process for the preparation of compound;
- V. Claims 72 and 73 drawn to a method of treating a disease,

and election of a single disclosed species was required. In response, Applicants elected Group I and the species (S)-N-{1-[4-(3-Fluoro-benzyloxy)-phenyl]-2-oxo-pyrrolidin-3-yl}-acetamide with traverse. The following claims were indicated to read upon the elected species: claims 1 to 4, 7 to 9, 12 to 14, 17 to 19, 24, 25, 29 to 31, 33 to 39, 55, 59 to 63, 65, 67, 68, and 71 to 73.

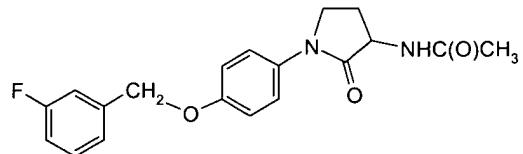
The reasons provided for restriction of the claims was that the compounds have a diverse chemical structure providing different properties, effects, etc. In response, Applicants pointed out that all of the subject

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matter of groups II and III is encompassed by the subject matter of Group I, and, therefore, the compounds of Groups II and III are not structurally diverse from those of Group I, and there is no undue burden on the Patent Office to examine these groups with the elected Group I.

Applicants appreciate the Examiner's rejoinder of Group II. The Office Action states that Group III, claims 64 to 66 have not been rejoined because they are structurally distinct from the compounds of Group I and II. Applicants continue to traverse this restriction because, as shown below in the discussion of the elected species and subgeneric concept created by the Patent Office, the compounds of claims 64 to 66, are wholly encompassed by claim 1. For this reason and those provided below, Group III should be rejoined with Groups I and II.

In response to the election of species, Applicants elected the species (S)-N-{1-[4-(3-fluoro-benzyloxy)-phenyl]-2-oxo-pyrrolidin-3-yl}-acetamide, which is the species of example 10 and, notably, the third compound listed in claim 65. This compound has the following structure:



The Office Action states that the Patent Office has examined compounds of formula I as shown in claim 1, wherein X-Y is limited to $-\text{CH}_2\text{-O-}$, R^4 is limited to $-\text{CONHR}^5$, and $\text{R}^1, \text{R}^{1.1}, \text{R}^{1.2}, \text{R}^{21}, \text{R}^{22}, \text{R}^{23}, \text{R}^{24}, \text{R}^3$, and R^5 are as claimed. In other words, the Patent Office has created its own subgeneric concept for examination in which R^4 is limited to $-\text{CONHR}^5$. Clearly this generic structure does not encompass Applicants' elected compound. Therefore, Applicants respectfully submit that search and examination of compounds of formula I should be extended to those compounds wherein R^4 is NHR^6 .

With regard to claims 64 to 66, Applicants note that every species recited in claim 64 is encompassed by the generic concept which the Patent Office indicates has been searched and examined. Thus, there is no burden upon the Patent Office to rejoin this claim. Further, all of the species of claims 65 and 66, contain $\text{R}^4 =$

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NHR⁶. Examination of the subject matter encompassing the elected species would necessarily encompass search and examination of these claims as well. Thus, Applicants respectfully request that claims 64 to 66 be rejoined and examined with Groups I and II.

With regard to the Patent Office's creation of its own subgeneric concept, Applicants reiterate that it is improper for the Patent Office to create its own subgeneric concept and require limitation of the claims to such concept for the reasons provided in Applicants response of November 23, 2005, incorporated herein by reference.

Further, Applicants note that the Office Action states that the "Examiner may reconsider to rejoin method of use claims commensurate in scope with the product claims when the case would be found in condition for allowance [provided those method claims are free from 35 U.S.C. § 112 first including written description, reach-through claim language and/or scope of enablement issues] and second paragraph]." Applicants respectfully submit that rejoinder is not optional when the compound and process claims are originally submitted in an application and the method claims are of the same scope as the allowable compound claims. Further, the existence of any § 112 issues does not excuse rejoinder of the method claims, rather, as discussed in M.P.E.P. § 821.04, the method claims are to be rejoined and fully examined on the merits.

PROVISIONAL REJECTION OF CLAIMS 1 TO 63, 67, AND 68 UNDER THE DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER US APPLICATION NO. 10/667,087

Claims 1 to 63, 67, and 68 stand provisionally rejected over claims 1 to 48 of copending application No. 10/667,087 ("the '087 application"). In particular, the office action states that although the claims of the two applications are not identical, they are not patentably distinct because the compounds in the two applications are similar and allegedly a reference that anticipates one set of claims would render the other set of claims obvious.

Applicants respectfully traverse this rejection because the compounds of the instant application are not obvious over those claimed in Application No. 10/667,087 for at least the following reasons. The

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compounds of the instant application and the ‘087 application are patentably distinct. In particular, the compounds of the ‘087 claims require that R³ is –NHR⁶. In contrast, the compounds of the instant claims require that R³ is hydrogen. There is nothing in the ‘087 application to teach or suggest substituting a hydrogen atom for the –NHR⁶ group at the R³ position. Thus, the compounds of the instant claims are not obvious over those of the ‘087 claims.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

PROVISIONAL REJECTION OF CLAIMS 1 TO 63, 67, AND 68 UNDER THE DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING OVER US APPLICATION No. 10/667,088

Claims 1 to 63, 67, and 68 stand provisionally rejected over claims 1 and 3 to 49 of copending application No. 10/667,088 (“the ‘088 application”). In particular, the office action states that although the claims of the two applications are not identical, they are not patentably distinct because the compounds in the two applications are similar and allegedly a reference that anticipates one set of claims would render the other set of claims obvious.

Applicants respectfully traverse this rejection because the compounds of the instant application are not obvious over those claimed in Application No. 10/667,088 for at least the following reasons. The compounds of the instant application and the ‘088 application are patentably distinct. In particular, the compounds of the ‘088 claims require that R³ is –C(O)N(H)CH₃ or –CH₂CN. In contrast, the compounds of the instant claims require that R³ is hydrogen. There is nothing in the ‘088 application to teach or suggest substituting a hydrogen atom for the –C(O)N(H)CH₃ or –CH₂CN group at the R³ position. Thus, the compounds of the instant claims are not obvious over those of the ‘088 claims.

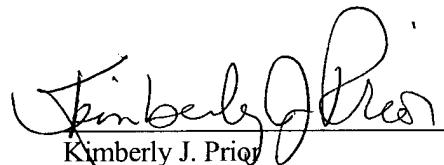
For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

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The foregoing amendment is fully responsive to the Office Action issued December 23, 2005.
Applicants submit that Claims 1 to 73 are allowable. Early and favorable consideration is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,



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